

REMARKS/ARGUMENTS

Claims 1-40 are pending in the present application. In the Office Action mailed April 20, 2005, the Examiner rejected claims 1-4, 7, 8, 13-20, 23, 24, 29-35 and 37 under 35 U.S.C. § 102(e). The Examiner also rejected claims 5, 6, 9-12, 21, 22, 25-28, 36 and 38-40 under 35 U.S.C. § 103.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

A. Rejection of Claims 1-4, 7, 8, 13-20, 23, 24, 29-35 and 37 under 35 U.S.C. § 102(e)

The Examiner rejected claims 1-4, 7, 8, 13-20, 23, 24, 29-35 and 37 under 35 U.S.C. § 102(e) as being anticipated by International Publication No. WO 02/070088 to Puskala (hereinafter, "Puskala"). This rejection is respectfully traversed.

Section 102(e) provides that a patent may be granted unless . . .

the invention was described in . . . an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent . . . , except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

(Emphasis added.)

Puskala did not designate the United States and, as a result, is not deemed to be "filed in the United States" as required by Section 102(e). Therefore, Puskala is simply not prior art under Section 102(e) and thus cannot be cited against the present invention.¹

¹ See, e.g., M.P.E.P. § 706.02(f)(1) at p. 700-38 (a flow chart showing that Puskala is not entitled to a priority date under 102(e) because the United States was not designated) (attached hereto as Exhibit 1) and at P. 700-32 ("If the IA [an international application for which there is no priority date under 102(e)] properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e) date for all the references.").

Accordingly, the Applicants respectfully request that claims 1-4, 7, 8, 13-20, 23, 24, 29-35 and 37 be allowed over the cited references.

B. Rejection of Claims 5, 6, 21, 22 and 36 under 35 U.S.C. § 103(a)

The Examiner rejected claims 5, 6, 21, 22 and 36 under 35 U.S.C. § 103(a) based on Puskala in view of U.S. Publication No. 2002/0174106 to Martin (hereinafter, "Martin"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. In particular, the cited references do not teach or suggest all of the limitations in these claims.

Claims 5, 6, 21, 22, and 36 depend from independent claims 1, 13, and 29 that require sending a user-selected "preconfigured message" through a global computer network. The cited references do not teach or suggest this limitation.

As shown above, Puskala is not properly citable under Section 102(e) and thus cannot be considered prior art under Section 103. Further, the cited excerpts of Martin do not teach sending user-selected preconfigured messages, as claimed in the present application, but teach user-created messages. *See, e.g.*, Martin at Abstract (“an input text expression from a user”) and ¶ 64 (“the user enters various keywords”).

Accordingly, Applicants respectfully request allowance of claims 5, 6, 21, 22, and 36 over the cited references.

C. Rejection of Claims 9-12, 25-28 and 38-40 under 35 U.S.C. § 103(a)

The Examiner rejected claims 9-12, 25-28 and 38-40 under 35 U.S.C. § 103(a) based on Puskala in view of U.S. Publication No. 2002/0178353 to Graham (hereinafter, “Graham”). This rejection is respectfully traversed.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. More specifically, the cited references do not teach or suggest all of the limitations in these claims.

Claims 9-12, 25-28, and 38-40 depend from independent claims that require sending a user-selected “preconfigured message” through a global computer network. The cited excerpts do not teach or suggest this limitation.

As shown above, Puskala is not properly citable as prior art under Section 103. Further, the cited portions of Graham do not teach sending user-selected preconfigured messages, as claimed in the present application, but, instead, relate to a secure messaging system. *See, e.g.*, Graham at Abstract (disclosing a “secure document delivery system”).

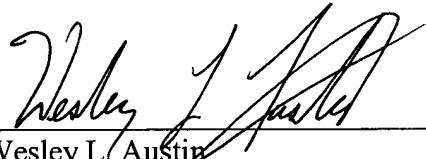
Applicants thus respectfully request allowance of claims 9-12, 25-28, and 38-40 over the cited references.

Appl. No. 09/928,856
Amdt. dated August 19, 2005
Reply to Office Action of April 20, 2005

D. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin", is written over a horizontal line.

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

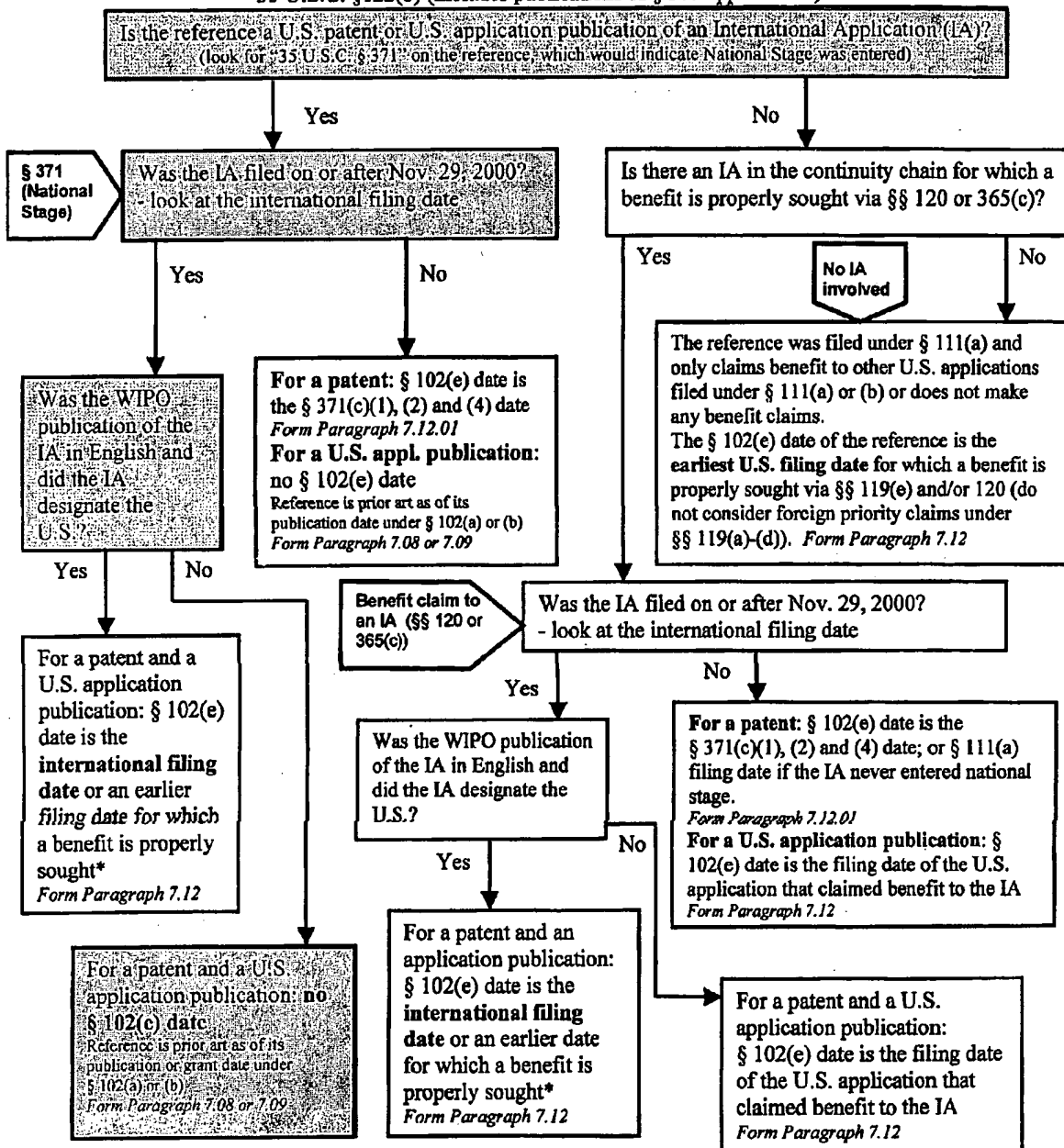
Date: August 19, 2005

MADSON & METCALF
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700



706.02(f)(1)

MANUAL OF PATENT EXAMINING PROCEDURE

FLOWCHARTS FOR 35 U.S.C. § 102(e) DATES:**Apply to all applications and patents, whenever filed****Chart I: For U.S. patent or U.S. patent application publication under 35 U.S.C. § 122(b) (includes publications of § 371 applications)**

* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.